

PTO/SB/33 (07-05)

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional) 080342-000000US	
I hereby certify that this correspondence is being facsimile transmittal to the USPTO at 571-273-8300 on <u>December 14, 2005</u> Signature <u>Julie Taylor Clough</u> Typed or printed name <u>Julie Taylor Clough</u>		Application Number 09/631,101	Filed August 1, 2000
		First Named Inventor Harold David Gunn	
		Art Unit 2176	Examiner James H. Blackwell
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant/inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number <u>35,933</u></p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>35,933</u></p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p>			
<p><input type="checkbox"/> *Total of _____ forms are submitted.</p>			

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PATENT
Docket No.: 080342-000000US
Client Ref. No.: 81778-1CIP

TOWNSEND and TOWNSEND and CREW LLP

By: Julie Taylor Clough

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

HAROLD DAVID GUNN et al.

Application No.: 09/631,101

Filed: August 1, 2000

For: DATA ENTRY FOR PERSONAL
COMPUTING DEVICES

Examiner: James H. Blackwell

Art Unit: 2176

PRE-APPEAL BRIEF REQUEST FOR
REVIEW

Mail Stop: AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicants request review of the final rejection mailed by the Office for the above-identified application on June 14, 2005 ("the Final Office Action"). An Advisory Action was mailed on September 16, 2005 indicating that the reply filed on August 15, 2005 did not place the application in condition for allowance. Applicants believe the rejections contain a clear factual deficiency.

A Notice of Appeal is being filed concurrently herewith.

1. Status of Claims

Claims 1-56, 83-85, 96-106, 130-133, 136-139 and 142-189 are pending and stand finally rejected.

HAROLD DAVID GUNN et al.
Application No.: 09/631,101
Page 2

PATENT

2. Rejections

In the Final Rejection mailed June 14, 2005, claims 1-5, 9, 14-21, 24, 30-32, 38-39, 46-53, 57, 83-85, 96-100, 105-106, 131, 133, 155-162, 164-171 and 189 were rejected under 35 USC §103(a) as being unpatentable over Miller (U.S. Patent No. 5,805,911) in view of Hachamovitch et al. (U.S. Patent No. 6,377,965).

Claims 6, 8, 10-11, 130, 132 and 136-139 were rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch and further in view of Agulnick et al. (U.S. Patent No. 5,347,295).

Claim 7 was rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch and further in view of Forcier (U.S. Patent No. 5,220,649).

Claims 12-13 and 26 were rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch and further in view of Niemeier (U.S. Patent No. 5,574,482).

Claims 22-23, 25, 33-34, 54-55, 101-104, 142-145, 163 and 172-188 were rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch and further in view of Skinner et al. (U.S. Patent No. 6,661,920).

Claims 27-29 were rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch, further in view of Skinner and further in view of Lee (U.S. Patent No. 6,292,179).

Claim 35 was rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch, further in view of Skinner, and further in view of LaGrange et al. (U.S. Patent No. 5,896,321).

Claims 36-37 and 40-42 were rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch, further in view of Skinner, and further in view of Bi et al. (U.S. Patent No. 6,262,719).

HAROLD DAVID GUNN et al.
Application No.: 09/631,101
Page 3

PATENT

Claim 43 was rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch, further in view of Skinner, further in view of Bi, and further in view of LaGrange.

Claim 44 was rejected under 35 USC §103(a) as being unpatentable over Miller in view of Hachamovitch, further in view of Bi and further in view of Skinner.

3. Reasons for Requesting Review

On August 15, 2005 applicants submitted an Amendment Under 37 CFR 1.116 Expedited Procedure. In response thereto the Examiner mailed an Advisory Action on September 16, 2005 rejecting applicants' arguments presented in the Amendment Under 37 CFR 1.116 Expedited Procedure. In rejecting the arguments submitted in applicant's response on August 15, 2005, the Examiner has asserted that "the response substantially focuses on actions occurring as a result of the entry of at least a first character" (Advisory Action, para. 11). However, the Examiner argues that "the language recited in this limitation is open ended and therefore would allow for the possibility of more than a single character invoking a response as is taught in Miller and Hachamovitch" (Advisory Action, para. 11). In the Advisory Action, the Examiner did not mention any of the grounds of rejection outlined in the Final Rejection. Accordingly, applicants respectfully submit that for the reasons presented in the Amendment Under 37 CFR 1.116 Expedited Procedure filed on August 15, 2005, there are clear errors present in the rejections and a prima facie case for obviousness of the claims in view of the cited references has not been established.

With regard to the Advisory Action, the Examiner has rejected applicants' claim 1 on the ground that the language recited in its limitation "allow[s] for the possibility of more than a single character invoking a response." In particular, the Examiner has mistakenly interpreted Claim 1 as covering a method in which a list of completion candidates is obtained in response to receipt of, for example, the third character of the partial text entry, as taught by Miller, for example. It appears that the Examiner came to this erroneous conclusion by reading element (a) of Claim 1 in

HAROLD DAVID GUNN et al.
Application No.: 09/631,101
Page 4

PATENT

isolation from other elements of the claim. However, as recited in element (b) of Claim 1, a "list of completion candidates based on the partial text entry" is obtained "in response to receipt of the first character of the partial text entry." Thus, the trigger in Claim 1 for obtaining a list of completion candidates is clearly the receipt of the first character of the partial text entry.

In order for the Examiner's argument regarding the breadth of Claim 1 to succeed, the Examiner must of necessity interpret the language of Claim 1 as covering not obtaining a list of completion candidates based on the partial text entry in response to receipt of the first character in the partial text entry. However, such an interpretation clearly contradicts element (b) of Claim 1, which requires that a list of completion candidates based on the partial text entry be obtained in response to receipt of the first character in the partial text entry. Effectively, the Examiner's interpretation removes from Claim 1 the specific language "in response to... the first character" recited in element (b).

Claim 1 stands in clear contrast to methods such as those disclosed by Miller and Hachamovitch, which intentionally wait for the third character in a partial text entry before initiating any search to obtain a completion candidate. Not only do Miller and Hachamovitch fail to disclose or suggest the method recited in applicants' Claim 1, but, as set forth in applicant's previous submissions, both Miller and Hachamovitch expressly teach away from the applicants' method. Both Miller and Hachamovitch expressly teach that it is at best useless, and at worst counterproductive (e.g., "annoying"), to provide word predictions based on a single character. Applicants' claim 1 recites language covering precisely what Miller and Hachamovitch teach is undesirable, thus the claim cannot be considered obvious in view of Miller and Hachamovitch.

Accordingly, it is respectfully submitted that there are clear errors present in the rejection outlined in the Advisory Action and a prima facie case for obviousness of the claims in view of the cited references has not been established.

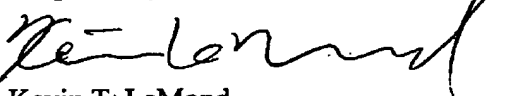
HAROLD DAVID GUNN et al.
Application No.: 09/631,101
Page 5

PATENT

Thus, it is respectfully submitted that independent claim 1, as well as independent claims 47, 96, 155 and 189, are allowable for at least the above reasons along with the previously presented reasons in applicants' previous submissions.

Claims 2-46, 105 and 130-131 depend upon claim 1. Claims 48-56, 106 and 132-133 depend upon claim 47. Claims 97-104, 142-154 and 185-188 depend upon claim 96. Claims 156-184 depend upon claim 155. Accordingly, these claims are also allowable for at least the above reasons along with the previously presented reasons in applicants' previous submissions.

Respectfully submitted,



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Dated: 12/14/05

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